

ESTTA Tracking number: **ESTTA377670**

Filing date: **11/09/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77821763
Applicant	Parke-Bell Ltd., Inc.
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Submission	Appeal Brief
Attachments	Appeal Brief.pdf (11 pages)(530343 bytes)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Application of)	
)	
Parke-Bell Ltd., Inc.)	Trademark Attorney:
)	David H. Stine
Application Serial No: 77/821,763)	
)	Trademark Law Office: 114
Filed: September 8, 2009)	
)	
For: J WARREN)	

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Assistant Commissioner for Trademarks
2900 Crystal Drive, South Tower
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BRIEF FOR APPELLANT

INTRODUCTION

Pursuant to a Notice of Appeal filed with the Trademark Trial and Appeal Board on September 10, 2010, the Appellant hereby appeals from the Trademark Attorney's final refusal to register the above-identified mark, dated March 12, 2010, and respectfully requests the Trademark Trial and Appeal Board to reverse the Trademark Attorney's decision on the grounds that the Appellant's mark does not create a likelihood of confusion with the mark cited by the Trademark Attorney.

STATEMENT OF FACTS

Appellant seeks registration on the Principal Register of its mark, J WARREN, for works of art, namely, sculptures in International Class 6 and for home décor and furniture, namely, bedroom furniture, tables, chairs and home furnishings in International Class 20. The trademark application was filed on September 8, 2009 and received U.S. Trademark Application Serial No. 77/821,763.

The Trademark Attorney refused registration of Appellant's mark J WARREN in the First Office Action, dated December 9, 2009, contending that the mark, when used on or in connection with the recited goods, because of a likelihood of confusion with the following mark registered in International Class No. 16:

<u>MARK</u>	<u>REG NUMBER</u>	<u>GOODS</u>
J. WARREN	3,556,276	Photographs

The Trademark Attorney also found the identification of the goods unacceptable and suggested that the Appellant amend the goods and requested a written consent because the mark J WARREN identified a living individual.

In the Appellant's response to the Office Action, filed on March 3, 2010, Appellant provided a consent from J WARREN and

the Appellant argued that the cited registration and Appellant's mark were not likely to cause confusion because:

1. The goods were different; and
2. The United States Patent and Trademark Office has allowed the registration of the same marks so long as the goods or services were different.

The Appellant also amended the identification of the goods as suggested by the Trademark Attorney.

On March 12, 2010, the Trademark Attorney issued a Final Office Action and denied Appellant's application for registration finding Appellant's arguments unpersuasive based on the similarity of the marks and similarity of the goods and channels of trade.

ARGUMENT

I. APPELLANT'S GOODS ARE UNRELATED TO REGISTRANT'S GOODS SINCE THE GOODS ARE SOLD IN SEPARATE CHANNELS OF TRADE

Application of E.I. du Pont de Nemours & Co., 476 F. 2d 1357 (1973), sets forth the factors in determining likelihood of confusion under § 2(d) of the Lanham Act. The second factor under the likelihood of confusion test is that the Trademark Attorney must compare the goods in order to determine if the goods are related or if the activities surrounding their

marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). The Appellant states that its goods, namely, high end home furnishings, are not related to the Registrant's photographs.

The TMEP states that if the goods in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. TMEP Section 1207.01(a)(i). See, e.g., *Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services). The Appellant believes that its goods, namely, home decor is purchased by skilled decorators are not related to Registrant's photographs purchased by consumers that want sports related photographs in such places as sports bars or the rooms of sports enthusiasts.

The Appellant respectfully disagrees with the Trademark Attorney's argument that because certain registration covers home décor and photographs that, therefore, all photographs are "related" to home décor for purposes of the likelihood of confusion analysis. Following that logic, all items sold as

home decor are "related" and could cause confusion. For example, lamps are thus related to photographs and tables are related to lamps merely because such goods are offered as home décor.

This is further supported by the Trademark Attorney's submission of excerpts from certain registrations in support of the contention that Appellant's and Registrant's goods are marketed and sold to the same classes of purchasers through the same channels of trade. However, the registrations merely demonstrate that large retail establishments or mail-order houses sell every conceivable type of home goods, etc. It does not demonstrate that home décor and photographs are related, only that they are both are sold by some unrelated third party owners.

Moreover, the Registrant's goods and the Appellant's goods are classified in different International Classes which supports the Appellant's argument that the goods are different.

II. GOODS ARE PURCHASED BY SOPHISTICATED PURCHASERS

The Appellant's goods are generally sold to sophisticated purchasers who know the difference between home décor such as sculptures and photographs.

Appellant is a well known worldwide seller of high end home furnishings whereas the proprietor of the cited registration

apparently sells only photographs of sporting events and the like.

A purchaser of Appellant's goods spends time selecting the type of style of furnishing that will go into their home. Some of the Appellant's goods are expensive and the Appellant's customers do not make uninformed decisions before purchasing the home décor from the Appellant.

Therefore, the sophisticated purchaser uses great care in the selection, research and purchase of Appellant's goods whereas registrants customers make a quick hit and determine if they want to purchase a sporting event photograph. See *TEMP Section 1207.01(d)(vii)*.

Moreover, Appellant does not sell photographs.

A careful review of the sales literature of the owner of the cited mark shows that they sell only photographs mostly relating to sports.

III. APPELLANT'S GOODS ARE UNRELATED TO REGISTRANT'S GOODS

SINCE THERE IS NO "PER SE" RULE THAT ALL HOME DECOR ARE RELATED

Not all purchasers of home decor buy photographs and vice versa.

The Trademark Attorney must determine whether there is a likelihood of confusion on the basis of the goods identified in

the application and registration. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). The goods identified in U.S. Registration No. 3,556,276 are for photographs and only photographs. Following the Trademark Attorney's logic, this registration is not just for photographs, but encompasses any and all types of home furnishings, since any and all home goods items are "related".

The Trademark Office requires that an applicant specifically list the types of home goods by common commercial name in the identification of goods.

The Appellant believes that the purpose of this exercise is so that "photographs" will not encompass other types of goods which do not relate to the photographs.

The reason for specifically listing the type of home decor and not merely filing by international class is to differentiate between the types of home décor, so that the likelihood of confusion determination is not routine, but judged based upon the realities of how products are sold or marketed.

In other words, we cannot create imaginary scenarios which rationalize the finding of confusion between two "unrelated" types of home decor, merely because in some imaginary marketplace, these particular goods could conceivably be sold through the same channels of trade to the same classes of purchasers.

Therefore, since photographs are not related only to home furnishings, there would be no likelihood of confusion between the marks.

In the cited registration the goods are very specific and, therefore, entitled to very narrow interpretation. The cited registration owner is entitled to protection against registration of a similar mark on products that might reasonably be expected to be sold in the normal expansion of the owner's business or industry. However, that does not mean that all home goods are covered by the cited registration merely because it covers photographs. As stated in *CPG Products Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983), the test is whether consumers believe the goods are within the cited registration's logical area of expansion.

It is difficult to imagine a consumer reasonably believing that someone who sells photographs would expand to sell high end home décor such as sculptures or tables, etc.

The cited owner's mark is not a well known mark such as "PEPSI" or "COKE" and consumers are not deceived by any trademark similarity when a mark is known only to relatively small or select groups and not to the general public. *Scott v. Meyo International, Inc.*, (DC Minn 1981) 213 USPQ 824. Here the cited owner sells only photographs and such goods are targeted

to a select group of people searching to purchase a photograph of a famous person or a sports related photograph.

**IV. REGISTRATION BY UNITED STATES PATENT AND TRADEMARK OFFICE
OF SAME MARKS FOR DIFFERENT GOODS**

The Appellant submits that the United States Patent and Trademark Office has established a policy of allowing the registration of the similar marks in the same class if the goods or services are slightly different. In support, Appellant submits the following example of such policy:

<u>MARK</u>	<u>REG. NO.</u>	<u>INT. CLASS</u>	<u>GOODS</u>
1. INTELLISENSE	1,928,224	9	Diagnostic monitor for determining the position of rotor assemblies
2. INTELLISENSE	1,906,360	9	Instruments for measuring, sensing, analyzing and monitoring gases
3. INTELLISENSE	1,932,308	9	Dishwashing machines and parts thereof
4. INTELLISENSE	1,755,084,	9	Infrared motion sensors, electronic glass break detector and temperature sensors

Clearly the above marks are the exact same marks and cover goods which are closely related or marketed in the same channels

of trade and they were registered by the United States Patent and Trademark Office despite the marks being exactly the same.

In the instant cases, the Appellant's goods and the cited mark's goods are completely different, for different uses by different purchasers.

Thus, since the United States Patent and Trademark Office has adopted a policy of allowing the same mark to different proprietors for somewhat similar goods or services and Appellant's mark is also entitled to registration.

**V. COMPARISON OF MARKS USE DEMONSTRATES NO LIKELIHOOD OF
CONFUSION**

Even though the marks are similar, the inquiry into the degree of similarity between the marks does not end with a mere comparison of the marks side by side. A comparison of the way in which the marks are used affects the marks' appearance and impression on the consumers. *Tetley, Inc. v. Topps Chewing Gum, Inc.*, 277 USPQ 1128(DC ENY, 1983). In *Springs Mills, Inc. v. Ultracashmere House, Ltd.*, (DC SNY, 1982) 215 USPQ 1057, the Court stated that the setting in which the marks are found is relevant to the question of similarity.

In this case, the specimens submitted by the cited owner and by the Appellant show how differently the marks are used. The cited owner uses the mark in block letters stamped on the

front of a photograph. In contrast, the Appellant's mark appears as a signature on the goods.

CONCLUSION

For the reasons set forth hereinabove, Appellant submits that there is no likelihood of confusion, mistake or deception between Appellant's mark and prior cited registration. Accordingly, Appellant's mark is entitled to registration.

The Board is therefore respectfully requested to reverse the decision refusing registration of Appellant's mark.

Respectfully submitted,
PARKE-BELL LTD., INC.
By its attorneys

Date: November 9. 2010

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